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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,248	06/29/2000	Jen-chi Liu	EM/LIU/5784	7660

7590 05/17/2004

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EXAMINER

NGUYEN, BRIAN D

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/606,248

Applicant(s)

LIU ET AL.

Examiner

Brian D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment filed 4/28/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9 and 12 is/are rejected.
- 7) ☒ Claim(s) 3 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 7-9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berggren et al (6,658,253).

Regarding claims 1 and 8, Berggren discloses a communication method for enabling a mobile host to initiate a voice call with a communication terminal via Internet and cellular networks (see figures 2 & 6). The method comprising comparing, when the mobile host roams from an area controlled by the first switching center (14) to an area controlled by the second switching center (16), the first gateway (the gateway services the first network 14 for connecting to the Internet) connected to the first switching center and invoking a call transfer procedure from the third gateway to the first gateway to establish a new connection between the third gateway and a device at the other end of the communication gateway (see col. 1, lines 33-37; col. 2, lines 15-26; col. 3, lines 38-45; col. 4, lines 4-49). Berggren does not specifically disclose a second gateway. However, it is well known in the art that a gateway is connected to the Internet to convert information between the Internet network and other network. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a second gateway at the other end of the communication so that the Internet network can be used in the communication between users.

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Regarding claims 2, 8-9, and 12, Berggren further discloses performing location update (see col. 4, lines 1-3; figure 2).

3. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berggren et al (6,658,253) in view of Emery et al (6,519,242).

Regarding claims 3 and 10, Berggren discloses all the claimed subject matter as described in previous paragraph except for explicitly discloses the gateway exchanges information such as registration request with a gatekeeper. However, it is well known in the art that the gateway will contact the gatekeeper to determine if the subscriber is a local subscriber. Emery discloses a gatekeeper for exchanging the registration and admission with the gatekeeper (see col. 4, lines 12-45; col. 6, lines 16-42). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to exchange information with the gatekeeper as taught by Emery in the system of Berggren in order to avoid disconnection when the subscriber move from the home network to a visitor network (see col. 5, lines 31-38).

Response to Arguments

4. Applicant's arguments filed 4/28/04 have been fully considered but they are not persuasive.

The applicant argued that the call transfer of the claimed invention is achieved without the public switching telephone network and Berggren does not disclose any procedure for transferring a call that is initially being carried by Internet from a first mobile switching station to a second mobile switching station, so that the call can be continue to be carried by the internet between a third mobile switching station and the second mobile switching station. This argument

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is not persuasive because the MSC in Berggren can include a gateway so that the call can be carried over the Internet (see col. 4, lines 18-34). Figures 2 and 3 clearly show roaming and figure 6 show the network is the Internet network.

Allowable Subject Matter

5. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (703) 305-5133. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

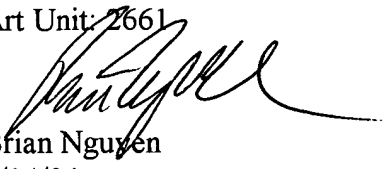
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Brian Nguyen
5/14/04